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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,430	11/23/2001	Vineet Rajgarhia	00-1237-A	5475

20306 7590 02/09/2005

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EXAMINER

PAK, YONG D

ART UNIT PAPER NUMBER

1652

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/992,430

Applicant(s)

RAJGARHIA ET AL.

Examiner

Yong D Pak

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4 and 7-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 30, 2004 has been entered.

Claims 1, 3-4 and 7-23 are pending. Claims 16-23 are withdrawn. Claims 1, 3-4 and 7-15 are pending.

### ***Election/Restrictions***

Applicant's election with traverse of Group I in Paper No. 21 is acknowledged.

Claims 16-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 21.

Notice of Possible Rejoinder: The Examiner notes that if claims 1, 3-4 and 7-15 are found directed to an allowable product, then claims 16-23, which are directed to the process of using the patentable product, previously withdrawn from consideration as a

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result of a restriction requirement, would now be rejoined pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86; see also MPEP 821.04, *In re Ochiai*, and *In re Brouwer*). Since process claims 16-23 would be rejoined and fully examined for patentability under 37 CFR 1.104, applicants are instructed to amend said claims as deemed necessary according to rejections made against the elected claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, the phrase "yeast cell produces a reduced amount of a glycolytic enzyme" is unclear. The metes and bounds of the phrase in the context of the above claim is not clear to the Examiner. It is not clear to the Examiner if these enzymes are produced in "reduced amount" by inactivating the gene encoding said enzyme or if the expressed enzymes are inactivated.

It is also not clear to the Examiner as to how much of a decrease in the production of these enzymes compared to their normal production levels is considered as "reduced" by the applicants. A perusal of the specification did not provide a clear

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definition for the above phrase. Without a clear definition in terms of numerical value, those skilled in the art would be unable to conclude what is meant by "produces a reduced amount..".

### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed on December 30, 2004 is insufficient to overcome the rejection of claims 1, 3-4 and 7-15 based upon Rajgarhia et al. (U.S. Patent No. 6,485,947) as set forth in the last Office action because: the declaration is unsigned.

### ***Response to Arguments***

Applicant's arguments filed on December 30, 2004 have been fully considered and are not persuasive.

### ***Claim Rejections - 35 USC § 102***

Claims 1, 3-4 and 7-15 remain rejected under 35 U.S.C. 102(e) as being anticipated by Rajgarhia et al.

Applicants argue that Rajgarhia is an inventor of the U.S. Patent No. 6,485,947, and the instant application and that the invention disclosed in the reference patent and the claims of the instant application are his own and not the invention of another. Applicants have submitted a declaration under 37 CFR 1.131 to demonstrate that the invention disclosed but not claimed in the reference was derived from the inventor of

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this application and is thus not the invention "by another,". However, as stated above, the declaration is unsigned and therefore ineffective to overcome the rejection.

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Yong D. Pak  
Patent Examiner 1652



Manjunath Rao  
Primary Examiner 1652